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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,215	03/18/2004	Simon Daniel Brueckheimer	41319-95738	5835
23644 7590 07/09/2008 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786				
EXAMINER				
DUONG, FRANK				
ART UNIT		PAPER NUMBER		
2616				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

Office Action Summary

Application No.

10/803,215

Applicant(s)

BRUECKHEIMER ET AL.

Examiner

Frank Duong

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-61 and 63-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 11-57 and 78-104 is/are allowed.
- 6) ☒ Claim(s) 58-61 and 63-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/242,500.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is a response to communications dated 04/08/08. Claims 11-61, 63-104 are pending in the application.

Terminal Disclaimer

2. The terminal disclaimer filed on 04/08/08 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of patent number 6,731,635 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 58-61 and 63-77 are rejected under 35 U.S.C 112, first paragraph, as based on a single means claim, i.e. (*a mini-cell assembler; a look-up table or a multiplexer*), where a means recitation does not appear in combination with another recited element of means. A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor. It has been held in Hyatt that when claims depend on a recited property, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the

specification discloses at most only those known to the inventor. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197(Fed. Cir. 1983). In the present condition, although claims 58-61 and 63-77 do not recite even a single means, they are analogous to single means claims in that they recite neither a specific structure nor a combination of means. In the absence of any recitation of structure or multiple means, claims 58-61 and 63-77 are not drawn to a combination. Thus the claims appear to cover "*every conceivable means for achieving the stated*" property, whereas the specification discloses only those limited means or elements known to the inventor.

4. Claims 58-77 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For the same rationales discussed in the single means rejection, a question of enablement is raised because in the original specification, there is neither support or discussion that each claimed element can be enabled without the interaction or interconnection with or to other elements.

Allowable Subject Matter

5. Claims 11-57 and 78-104 are allowed.
6. The following is an examiner's statement of reasons for allowance: The Terminal Disclaimer filed 04/08/08 overcomes the outstanding rejection.

The prior art of record, considered individually or in combination, fails to fairly show or suggest the claimed method of assembling traffic, comprising, among other limitation, a novel and unobvious limitation of "*storing information pertaining to a mini-cell length associated with that user's mini-cell; and multiplexing the mini-cells into ATM cells,*" structurally and functionally interconnected with other limitations in a manner as recited in claims 11-30.

The prior art of record, considered individually or in combination, fails to fairly show or suggest the claimed method of assembling traffic, comprising, among other limitation, a novel and unobvious limitation of "*determining from the stored information the respective mini-cells lengths of said user's mini-cells in order to delineate said mini-cells in each ATM cell received at said egress,*" structurally and functionally interconnected with other limitations in a manner as recited in claims 31-57.

The prior art of record, considered individually or in combination, fails to fairly show or suggest the claimed system of transmitting traffic, comprising, among other limitation, a novel and unobvious limitation of "*means at an egress of the ATM connection for determining from the stored information the respective mini-cells lengths of said user's mini-cells in order to delineate said mini-cells in each ATM cell received at said egress,*" structurally and functionally interconnected with other limitations in a manner as recited in claims 78-104.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

7. Applicant's arguments filed 04/08/08 have been fully considered but they are not persuasive. The amended claims 58-61 and 63-77 do not overcome the rejections for the rationales discussed above. Applicants, in a response to this Office Action, are suggested to further amend the claims to have physical connection or interconnection between the elements to overcome the aforementioned rejections and to place the instant application in a favorable condition for allowance.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is 571-272-3164. The examiner can normally be reached on 7:00AM-3:30PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn D. Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frank Duong/
Primary Examiner, Art Unit 2616
July 2, 2008